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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,694

03/26/2004

Takeshi Iwaki

OKI 293D1

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07/01/2008

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EXAMINER

PHAN, JOSEPH T

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

07/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/809,694	Applicant(s) IWAKI, TAKESHI	
	Examiner Joseph T. Phan	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e)/120 as follows:

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 11/29/2001. It is noted, however, that applicant has not filed a certified copy of the 363670/2001 application as required by 35 U.S.C. 119(b) in this application.

Applicant notes that the certified copy is in parent application 10/107165, however application 10/107165 is a divisional application and furthermore, the certified copy cannot be found in the divisional. Applicant is required to submit the certified copy in this application to verify support of claimed limitations and dates.

3. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Japan on 11/29/2001. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Information Disclosure Statement

4. The information disclosure statement filed 03/26/2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information

referred to therein has not been considered.

Applicant submits a previously signed PTO-1449 form from divisional application 10/107165 which is improper. The foreign references that were noted on the IDS filed 03/26/2004 needs to be resubmitted in an English translation as they cannot be found in the divisional.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 18-19 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 line 10 recites “the one user”, line 13 recites “the designated user”, and line 17 recites “the one user” which is unclear and confusing as there lack of antecedent basis. The ‘plurality of user names’ in line 6 recites ‘names’ and not a single ‘user’ and therefore it is unclear what users these are referring to. Furthermore, it is not known if they refer to the same one user or if there are different ones since there is a “plurality of user names”. Appropriate clarification and/or correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 9-12 rejected under 35 U.S.C. 102(e) as being anticipated by Kung et al., Patent #7,180,889.

Regarding claim 9, Kung teaches a communications terminal equipment connected to a single communication circuit for use by a plurality of users(Fig.7), comprising:
a memory for storing a plurality of user names and a plurality of extension numbers corresponding to the respective user names, and for storing a plurality of plans specifying planned activities and schedules for each of the plurality of users(Fig.7, col.30 lines 7-17 and lines 65-67, and col.31 lines 36-41; busy and unavailable are plans); and
a processor for providing in response to a call from a caller on the single communication circuit, a first voice message announcing to the caller the user names and corresponding extension numbers stored in the memory, and for providing in response to a designation by the caller of one of the announced user names(col.30 lines 54-60, col.31 lines 35-41 and col.32 lines 5-8), a second voice message announcing to the caller the planned activities and schedule of the designated user when the planned activities and schedule of the designated user indicate that the designated user is not available to answer the call(*col.30 lines 65-67 and col.31 lines 35-41; announcing to the caller that the user is simply busy*).

Regarding claim 10, Kung teaches a communications terminal equipment according to Claim 9, wherein the memory is a memory for also storing operation guides for use in generating the first and second voice messages(Fig-7-9, col. 31 lines 42-56)

Regarding claim 11, Kung teaches a communications terminal equipment according to Claim 9, wherein the plurality of user names are stored in the memory as respective speech

data(col.30 lines 54-60).

Regarding claim 12, Kung teaches a communications terminal equipment according to Claim 9, wherein the plurality of user names are stored in the memory as respective data based on reading and an accent type thereof(col.30 lines 54-60; accent is computer).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 13-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al., Patent #7,180,889.

Regarding claim 13, Kung teaches a communications terminal equipment connected to a single communication circuit for use by a plurality of users(Fig.7), comprising:
a memory for storing a plurality of user names and a plurality of extension numbers corresponding to the respective user names(Fig.7 and col.30 lines 54-60); and

a processor for providing in response to a call from a caller on the single communication circuit, a first voice message announcing to the caller the user names and corresponding extension numbers stored in the memory for providing in response to a designation by the caller of one of the announced user names(col.30 lines 54-60, col.31 lines 35-41 and col.32 lines 5-8), a second voice message requesting the caller to record a voice-mail message when the designated user is not available to answer the call(*col.30 lines 65-67 and col.31 lines 35-41*).

Kung is silent on specifically disclosing storing a plurality of e-mail addresses corresponding to the user names and sending the recorded voice-mail message to the stored e-mail address of the user.

However Kung discloses his system is configured to support email and voicemail messaging(col.11 lines 16-34, col.19 lines 8-17).

The examiner takes official notice that sending a voicemail to a stored email address of one of a plurality of users would have been obvious to one skilled in the art of IP telephony in which Kung discloses(col.11 lines 30-34). Sending voicemail to email addresses is old and well-known in the art as it provides a convenient and alternate way of managing voicemails.

Regarding claim 14, Kung teaches a communications terminal equipment according to Claim 13, wherein the memory is a memory for also storing a plurality of plans specifying planned activities and schedules for each of the plurality of users, and the processor is a processor for also determining on the basis of the planned activities and schedule of the designated user, when the designated user is not available to answer the call(*col.30 lines 65-67 and col.31 lines 35-41; announcing to the caller that the user is simply busy*).

Regarding claim 15, Kung teaches a communications terminal equipment according to

Claim 13, wherein the memory is a memory for also storing operation guides for use in generating the first and second voice messages(*col.30 lines 1-67 and col.31 lines 35-41*).

Regarding claim 16, Kung teaches a communications terminal equipment according to Claim 13, wherein the plurality of user names are stored in the memory as respective speech data(*Fig.7 and col.30 lines 1-67 and col.31 lines 35-41*).

Regarding claim 17, Kung teaches a communications terminal equipment according to Claim 13, wherein the plurality of user names are stored in the memory as respective data based on reading and an accent type thereof(*Fig.7 and col.30 lines 1-67 and col.31 lines 35-41; accent is computer*).

Regarding claim 18, Kung teaches a method of communicating with one of a plurality of users of a communications terminal equipment connected to a single communication circuit(*Fig.7-9*), said method comprising the steps of:

receiving a call from a caller on the single communication circuit; transmitting in response to the call, a first voice message announcing to the caller a plurality of user names and a plurality of corresponding extension numbers stored in a memory provided in the communications terminal equipment(*Fig.7 and col.30 lines 1-67 and col.31 lines 35-41*);

receiving a designated extension number selected by the caller from among the announced plurality of extension numbers(*col.30 lines 54-60, col.31 lines 35-41 and col.32 lines 5-8*);

determining whether or not the one user corresponding to the designated extension number is available to answer the call(*col.31 lines 35-41 and col.32 lines 5-8*);,

transmitting to the caller a second voice message requesting the caller to record a voice-mail message when the designated user is not available to answer the call;

recording the voicemail message received from the caller in response to the second voice message(col.30 lines 54-60, col.31 lines 35-41 and col.32 lines 5-8).

Kung is silent on specifically disclosing sending the recorded voice-mail message to the stored e-mail address of the user.

However Kung discloses his system is configured to support email and voicemail messaging(col.11 lines 16-34, col.19 lines 8-17).

The examiner takes official notice that sending a voicemail to a stored email address of one of a plurality of users would have been obvious to one skilled in the art of IP telephony in which Kung discloses(col.11 lines 30-34). Sending voicemail to email addresses is old and well-known in the art as it provides a convenient and alternate way of managing voicemails.

Regarding claim 19, Kung teaches a method of communication according to Claim 18, wherein the step of determining whether or not the one user is available to answer the call includes referring to a plurality of plans also stored in the memory specifying respective planned activities and schedules of the plurality of users(col.30 lines 54-60, col.31 lines 35-41 and col.32 lines 5-8).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joseph T Phan/
Examiner, Art Unit 2614
/Curtis Kuntz/
Supervisory Patent Examiner, Art Unit 2614